

## Remarks

### **I. Specification**

The Examiner has objected to the disclosure because “the cross-reference on page 3 of the specification has typographical error does not updated.” *June 16, 2006 Office Action*, at paragraph 5, page 2. The Specification has been amended to correct the application number cited in the CROSS-REFERENCE section. The Applicant appreciates the Examiner’s assistance with this.

### **II. Claim Rejections – 35 U.S.C. § 112**

The Examiner has rejected claims 1-4 and 6-30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *June 16, 2006 Office Action*, at paragraph 7, page 2. The Examiner states, “[t]he term ‘sufficiently close’ in claims 1 and 14 is a relative term which renders the claim indefinite.” *Id.* The Examiner further states, “the term ‘proximate’ in claim 27 is a relative term which renders the claim indefinite.” *Id.* at paragraph 7, page 3. In addition, “[d]ependent claims 2-13, 15-26, 28-30 are rejected for fully incorporating the dependencies of their base.” *Id.*

In response, the Applicant has amended claims 1, 14 and 27, such that these claims, and their dependent claims, are now fully compliant with the requirements of 35 U.S.C. 112, second paragraph.

In addition, the Applicant has amended claim 27 to remove inconsistencies. In particular, the phrase “electronically stored image” has been changed to “stored image,” as is consistent with the first element of the claim.

### III. Claim Rejections – 35 U.S.C. § 103

**Claims 1-4, 6, 13-19, and 27 are not unpatentable over Blank in view of Borovoy.**

The Examiner has rejected claims 1-4, 6, 13-19 and 27 under 35 U.S.C. 103(a) as being unpatentable over Blank, U.S. 5,469,536 (“*Blank*”) in view of Borovoy et al., U.S. 5,537,529 (“*Borovoy*”). *June 16, 2006 Office Action*, at paragraph 9, pages 3-9. The Applicant respectfully disagrees, and traverses the rejection.

Claims 1-4, 6, 13-19 and 27, as amended, are patentable over *Blank* and *Borovoy* for at least two reasons. First, the Examiner’s reasoning for combining the references is improper under the law of 35 U.S.C. § 103. Second, even if *Blank* and *Borovoy* are combined, the combined references do not disclose all the elements of claims 1-4, 6, 13-19 and 27.

A. The Examiner’s reasoning for combining *Blank* and *Borovoy* is improper under the law of 35 U.S.C. § 103.

In any obviousness determination, the patent examiner must determine the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art, as established in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Patentability turns on whether the subject matter as a whole sought to be patented was obvious to one with "ordinary skill in the art to which the subject matter pertains" in light of the prior art. *Id.* at 3. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. §2141.02, *citing, Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 U.S.P.Q. 698 (Fed. Cir. 1983) (emphasis in original).

Further, when making any obviousness determination, there must be a suggestion or motivation to modify a prior art reference. “Determining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness.” *Ruiz v. A.B. Chance*, 57 U.S.P.Q.2d at 1167, quoting, *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 225 F.3d 1349, 1356, 55 U.S.P.Q.2d 1927, 1931 (Fed. Cir. 2000). The suggestion, teaching or reason must come from the prior art itself; it cannot be based on hindsight in view of the claims. *McGinley v. Franklin Sports, Inc.*, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001), citing, *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1769 (Fed. Cir. 1999) (“guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”). In addition, no suggestion or motivation for modifying a reference exists if such a modification would render the invention of the reference unsatisfactory for its intended purposes. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

In this case, the combination of *Blank* and *Borovoy* is improper because there is no suggestion or motivation in the prior art to make such a combination. The Examiner has made the combination using impermissible hindsight, and the invention as a whole is not obvious.

The Examiner states “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention was made to have combined Borovoy’s teaching into Blank’s teaching to record interactions of painting the image, since the combination would have ‘provided to another person a communication that may be viewed in a live environment’ as Borovoy discussed.” *June 16, 2006 Office Action*, at paragraph 9, page 3.

Here, claim 1 is directed to a method of simulating the creation of a mock artist’s work

from an electronically stored image. The method includes *automatically selecting* a plurality of separate portions of the electronically stored image and *automatically displaying* a representation of each selected portion of the electronically stored image. Claim 14 is similarly directed to a system for simulating the creation of a mock artist's work, and includes means for *automatically selecting* a portion of the electronically stored image and means for *automatically displaying* a representation of each selected portion of the electronically stored image. Claim 27 is directed to a photography booth and also includes means for *automatically selecting* portions of the stored image and means for *automatically displaying* a representation of each selected portion of the electronically stored image.

In contrast, *Blank* discloses a system in which the *user* may choose to “work with an area of the image” or “work with an object.” *Blank*, at col. 33, lines 21-28; and FIGs. 19b and 19c. The *user* may then choose to perform a specific function on the selected object or area. *Blank*, at FIGs. 19b and 19c. As the Examiner acknowledged, “Blank does not explicitly disclose selecting and displaying steps are automatically steps.” *June 16, 2006 Office Action*, at paragraph 9, page 5.

*Blank* discloses a user interface made up of “menus, sub-menus, dialog boxes, and so forth in the Windows environment that are controlled by the keyboard...and pointing device...” *Blank*, at col. 31, lines 28-31; and FIG. 18. “By choosing a particular item in a dialog box, for example, the user controls a type, shape, or size of a manipulation tool that is visible on the video monitor. By another choice, the user can execute a particular command, operation or process. Thus, by using the Windows user interface to interact with the system, the user can manipulate or edit an image.” *Blank*, at col. 31, lines 32-37.

Modifying *Blank* by removing the user from the process, such that an area or an object is *automatically selected* for manipulation would destroy the intent, purpose and function of *Blank*, which is specifically intended to give the user the ability to edit digital images. As such, there is no suggestion or motivation for modifying *Blank*, because it would render *Blank* “unsatisfactory for its intended purpose.” *In re Gordon*, 733 F.2d at 902.

The second reference, *Borovoy*, discloses “a set of technologies, interfaces and methods which are able to trap the *user*’s interactions with a computer model while they are occurring” such that “each change or modification made by the *user* is recorded.” *Borovoy*, at col. 6, lines 19-25. These pre-recorded user interactions become a temporal sequence that may be played back. *Borovoy*, at col. 6, lines 49-61. The user may trigger the playback manually, or the user may program the playback to occur at a particular time, using standard operating system features. *Borovoy*, at col. 13, lines 49-60; and col. 14, lines 10-14. In either case, the playback is fundamentally nothing more than what was originally captured – the user’s interactions with an application.

*Borovoy* also includes a user interface, *Borovoy*, at col. 14, line 59 – col. 16, line 44; and FIGs. 7, 8A, 8B, and 8C. Different areas of the user interface permit the user: (1) “to access...different communications, such as videos and notes,” *Borovoy*, at col. 15, lines 16-17; (2) “interact[] with the application,” *Borovoy*, at col. 15, lines 31-32; (3) “determine[] which versions(s) are to be included in the temporal sequence,” *Borovoy*, at col. 16, lines 8-9; and (4) utilize[] [the] drag box to insert the version into a temporal sequence,” *Borovoy*, at col. 16, lines 10-11.

As with *Blank*, *Borovoy* does not disclose or suggest *automatically* selecting or displaying

a portion of an image, or *automatically* selecting a version to include in a temporal sequence. In fact, the word “automatic” is not used anywhere in the *Borovoy* specification. Again, as with *Blank*, removing the user from the process, such that a version is automatically included in the temporal sequence, would destroy the intent, purpose and function of *Borovoy*, which is to allow the *user* to create a temporal sequence. As such, there is no suggestion or motivation for modifying *Borovoy*, because it would render *Borovoy* “unsatisfactory for its intended purpose.” *In re Gordon*, 733 F.2d at 902.

The Examiner’s combination of *Blank* and *Borovoy*, then, is made without any suggestion in the art to make such combination. In fact, the only suggestion for *automatically selecting* a plurality of separate portions of the electronically stored image and *automatically displaying* a representation of each selected portion of the electronically stored image comes from Applicant’s Patent Application. Thus, without the impermissible reference to Applicant’s disclosure, there is no motivation to combine *Blank* with *Borovoy*, and the invention as a whole is not obvious.

B. Even if combined, *Blank* and *Borovoy* do not disclose all the elements of claims 1-4, 6, 13-19 and 27.

“To establish *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03, *citing, In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *Id.*, *citing, In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The combination of *Blank* and *Borovoy* does not disclose at least one element of the

claimed invention, either directly or inherently.

At best, the combination of *Blank* and *Borovoy*, if such a combination were proper, would disclose an image editing system in which the *user's* interactions with the user interface of the image editing system were trapped and recorded for future playback. For example, applying the disclosure in *Blank*, a user at the Windows user interface, *Blank*, at col. 31, lines 28-38; and Fig. 18, could select an area in an image by using the "Freehand Drag" option, *Blank*, at col. 33, line 50-col. 34, line 33; and FIG. 19b. The user could then "perform a mask procedure" to manipulate color in images. *Blank*, at col. 33, lines 29-37; col. 36, line 39-col. 41, line 6; and FIG. 19b. If these user actions, as disclosed in *Blank*, were combined with the disclosure in *Borovoy*, the user would perform these interactions in a specific area of the user interface, *Borovoy*, at col. 15, lines 31-32; and FIG. 7, ref. 701, and "[a]s the user interacts with the application," the interactions would be trapped and recorded as versions, *Borovoy*, at col. 15, lines 31-32. At a later time, the user could review the trapped and recorded versions and determine "which version(s) are to be included in the temporal sequence," *Borovoy*, at col. 16, lines 8-11. This temporal sequence could then be played back. *Borovoy*, at col. 13, line 47- col. 14, line 58; and FIG. 6.

As a result, then, of combining *Blank* and *Borovoy*, a user could use the *Borovoy* system to create a temporal sequence to teach or show a future viewer how to manually edit an image using the *Blank* system. This is clearly not the Applicant's claimed invention.

Therefore, with respect to claim 1, neither reference alone or in combination, discloses a method that includes automatically selecting a plurality of separate portions of the electronically stored image. In addition, neither reference alone or in combination, discloses a method that

includes automatically displaying a representation of each selected portion of the electronically stored image. With respect to claim 14, neither reference, alone or in combination, discloses a system that includes means for automatically selecting portions of the electronically stored image. In addition, neither reference alone or in combination, discloses a system that includes means for automatically displaying portions of the electronically stored image. With respect to claim 27, neither reference alone or in combination, discloses a photography booth that includes means for automatically selecting portions of the electronically stored image. In addition, neither reference alone or in combination, discloses a photography booth that includes means for automatically displaying portions of the electronically stored image.

In addition, neither reference alone or in combination, discloses a limitation, related to the sequence, common to all three independent claims. This limitation was added to claims 1, 14 and 27 as part of the claim amendments included in the Applicant's March 20, 2006 Response, but was not addressed by the Examiner in the most recent office action. *June 16, 2006 Office Action*, at paragraph 21, pages 27-28.

For example, in claim 1, "the selecting step includes determining a sequence for the portions of the electronically stored image such that at least one selected portion in the sequence is *not* contiguous with an immediately preceding portion in the sequence." This limitation is not disclosed in either *Blank* or *Borovoy*.

In *Blank*, once a file of an existing image is opened, *Blank*, at FIG. 19a, ref. 1022, the user may select multiple objects and/or areas for editing. "[I]f the user desires to perform additional area or object manipulations...the computer loops back through .. to repeat the steps 1026 through 1066." *Blank*, at col. 35, lines 47-53; and FIGs. 19b and 19c. There is nothing in



the *Blank* disclosure, or the diagrams of FIGs. 19 and 19b, that would prevent or deter a user from selecting a second area or a second object that is contiguous with the preceding selected area or object. As for the second reference, *Borovoy*, this limitation is not disclosed, as *Borovoy* is not directed to a system for editing digital images.

In summary, then, the references as a whole, whether looked at individually or in combination, do not directly or inherently disclose at least one element of the method of claim 1, the system of claim 14, or the photography booth of claim 27. Accordingly, combining *Blank* and *Borovoy*, even if proper, cannot be read as disclosing all the elements of claims 1, 14 or 27.

#### C. Conclusion

In conclusion, claims 1, 14 and 27, as amended, are patentable over *Blank* and *Borovoy* for at least two reasons. First, the Examiner's reasoning for combining the references is improper under the law of 35 U.S.C. § 103. Third, even if *Blank* and *Borovoy* are combined, the combined references do not disclose all the elements of claims 1, 14 or 27.

Claims 2-4, 6, 13, and 15-19, then, must also be patentable, since "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.03, *citing, In re Fine*, 837 F.3d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

#### IV. **Claim Rejections – 35 U.S.C. § 103**

##### **Claims 1, 7, 14 and 20 are not unpatentable over Cohen.**

The Examiner has rejected claims 1, 7, 14 and 20 under 35 U.S.C. 103(a) as being unpatentable over Cohen, U.S. 5,647,796 ("*Cohen*"). *June 16 Office Action*, at paragraph 14, page 16. In response, the Applicant has amended claims 1 and 14, and respectfully traverses the rejection.

Claim 1 has been amended to include the step of “associating each of a plurality of pixels in the electronically stored image with at least one display parameter value.” In addition, the step of “automatically selecting a plurality of separate portions of the electronically stored image” has been amended to include the limitation “where each pixel in the plurality of pixels has the same at least one display parameter value.” Claim 14 has been similarly amended. Support for these amendments may be found in the specification at least at page 14, third paragraph, page 16, and page 17, last paragraph.

A. Cohen does not disclose all the elements of claims 1, 7, 14 and 20.

As stated above, to establish obviousness “all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03. *Cohen* does not disclose at least one element of the claimed invention, either directly or inherently.

First, *Cohen* does not disclose the step of “storing at least one texture corresponding to a mock artist style.” Contrary to the Examiner’s statement, “painting or drawing a picture inherently the step of storing at least one display texture,” a texture is *not* a property of the electronically stored image. Rather, as disclosed in the specification of the present invention, the texture is used to *modify* the electronically stored image. Each mock artist style is associated with “[a] number of different textures.” *Specification*, at page 15; FIG. 6. The textures “represent a progressively darker drawing or painting area, and/or a particular color for a color output.” *Id.* For example, as shown in FIG. 6, a texture may be a set of diagonal lines or a set of curved lines. The claimed invention then “substitute[s] the stored display textures for the portions of the electronically stored image” having the appropriate display parameter value. *Specification*, at page 15. Clearly, then, the stored display texture is separate and distinct from

the stored image. The claimed invention would be pointless if this were not the case. As such, then *Cohen* does not disclose the first element of claim 1, “storing at least one texture corresponding to a mock artist style.”

Second, *Cohen* does not disclose all the limitations in the step of “automatically selecting a plurality of separate portions of the electronically stored image according to a sequence...” Specifically, *Cohen* does not disclose the limitation “where each pixel in the plurality of pixels has the same at least one display parameter value.”

In the present invention, the display value parameter associated with each pixel is used in the selecting step. For example, the display parameter value may be a grey scale value. *Specification*, at page 14. “Software resident in the computer...is enabled to determine the grey scale value of each pixel in the electronically-stored caricature image.” *Id.* The grey scale value associated with each pixel is then used in the selection step. “A pointer... is effectively moved...until the first pixel have a grey scale value in the range of the first texture... is encountered. *Specification*, at page 16. The pointer continues moving, searching for pixels having the same grey scale value, “until no more adjacent pixels having the correct grey scale value are found.” *Specification*, at page 16. “By this fashion, portion 267 of larger area 262 composed entirely of pixels having grey scale values in the selected range is identified.” *Specification*, at page 16; and FIG. 7B.

It should be noted that, while grey scale is used for the purposes of this example, and in the related discussion in the specification, this “does not limit the invention.” *Specification*, at page 14. “One or more display parameters other than grey scale (e.g. hue, RGB value, saturation) can be the parameter of the pixels for which a value is determined and used....” *Id.*

It is clear that the system disclosed in *Cohen* does not disclose selecting pixels based on display parameter values associated with those pixels. For example, FIGs. 5A, 5B and 5C in *Cohen* “illustrate a simulation in which the puzzle pieces, one at a time, suddenly appear at their predetermined screen positions.” *Cohen*, at col. 4, lines 47-50. Each puzzle piece is an object, and each object appears to be made up of different lines, different textures, and perhaps different colors.

**B. Conclusion**

In conclusion, claims 1 and 14, as amended, are patentable over *Cohen* because *Cohen* does not disclose all the elements of claims 1 and 14.

Claims 7 and 20, then, must also be patentable, since “[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.03, *citing, In re Fine*, 837 F.3d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

**V. Dependent claims 2-4, 6-13, 15-26, and 28-30 are patentable.**

Claims 2-4 and 6-13 are dependent upon claim 1, and are patentable at least for the same reasons set forth above for independent claim 1. Claims 15-26 are dependent up on claim 14, and are patentable at least for the same reasons set forth above for independent claim 14. Claims 28-30 are dependent upon claim 27, and are patentable at least for the same reasons set forth above for independent claim 27. As such, it is respectfully submitted that the application is in condition for allowance.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the

undersigned in Westborough, Massachusetts, (508) 898-1501.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'BM Dingman', with a stylized flourish at the end.

Brian M. Dingman

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